

REMARKS

Applicants have studied the Office Action dated June 28, 2004 and have made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-9, 11-19, and 21 are pending. Claims 10 and 20 were cancelled without prejudice or disclaimer. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- Rejected claims 1-21 under 35 U.S.C. §103(a) as being unpatentable over Miller (U.S. 5,920,701) in view of Klug et al. (US 2004/0010546 A1).

Examiner Interview

Applicants wish to thank Examiner Burgess for the telecom on Thursday October 28, 2004. Discussed was the teachings of Klug and the differences between CPU Utilization and CPU Speed. Also discussed was the numerical equation of weighted sums. Specifically, where the weighted sum rescales at least one of the response time and the CPU utilization to provide a sum of at least two quantities with a given numeric order of magnitudes

Rejection Under 35 U.S.C. §103(a) in View of Klug

As noted above, the Examiner rejected claims 1-21 under 35 U.S.C. §103(a) as being unpatentable over Miller (U.S. 5,920,701) in view of Klug et al. (US 2004/0010546 A1). Independent claims 1, 9, 11, 19 and 21 have been amended to distinguish over Miller taken alone and/or in view of Klug. On page 3 of the Office Action the Examiner correctly states "*Miller does not explicitly disclose*:

- *pinging at least one server to calculate locally at the client computer a response time between the client computer and the server;*
- *obtain percentage of CPU utilization of the client;*
- *calculating a weighted result of the response time and the CPU utilization;*
- *determining locally at the client computer a time for performing a download between the first threshold time value and the second threshold time value*

based on the weighted result."

and goes on to combine Miller with Klug.¹ Independent claims 1, 9, 11, 19 and 21 have been amended to recite:

calculating a weighted result of the response time and the CPU utilization calculating a weighted sum of the response time and the CPU utilization, where the weighted sum rescales at least one of the response time and the CPU utilization to provide a sum of at least two quantities with a given numeric order of magnitude;

Support for this amendment is found in the present invention as originally filed at page 12. No new matter has been added.

The Examiner continues on page 3 of the Office Action by citing Klug for disclosing "a wait time before downloading can take place. This wait time can be caused by a number of factors including the speed of the server, congestion, bandwidth, etc. (paragraphs [0011], [0051], [0053])." Independent claims 1, 9, 11, 19 and 21 distinguish over Miller taken alone in view of Klug.

As an initial matter, careful reading of Klug at paragraph 0053 reproduced below for convenience states:

If time information is to be utilized (90) the program determines (91) the approximate waiting time associated with a particular website access request. The approximate waiting time depends on a number of factors including the speed of the server at the selected website, the level of congestion on the Internet and any rerouting required by such congestion, the bandwidth of each leg of the route between the selected website and the user node, the processing speed of the user node, the operation of the browser, and the size and number of files that are downloaded before display can begin. Ideally, as many of these factors as possible should be taken into account in determining the approximate waiting time. For

¹ Applicants make no statement whether such combination is even proper.

example, the headers of protocol communications between the browser and the selected website convey information regarding the quantity of information that is to be downloaded. Such data is commonly used to provide displays during loading such as "15% of 7K" or the like. This information can be used to gain some information regarding the approximate waiting time, although it will be appreciated that actual waiting time may be longer than expected as multiple files may be linked by tags, i.e., a message embedded in one file may direct the browser to access another file at the selected website. The program can use such file size information together with information regarding the speed of the user node processor, the operation of the browser and empirical data gained through experience to approximate the waiting time and identify (92) messages to be displayed or played during the waiting time. Additionally, information regarding the expected waiting time and regarding the fastest communication network at the current time may be obtained by "pinging" one or more communications networks, e.g., issuing network access requests to the network(s) and measuring the response time for receiving a responsive signal.

(Emphasis Added).

The Applicants respectfully submit that "the processing speed of the user node" is not the same as "obtaining percentage of CPU utilization of the client" as recited in independent claims 1, 11, and 21 and "checking a percentage of CPU utilization of a client computer" in independent claims 9 and 19. The use of "the processing speed of the user node" as taught by Klug is in reference to how "fast" a user node is running e.g. what "speed" which is typically measured in Megahertz (or higher units e.g. Terahertz of time). In contrast, as recited in the independent claims of the present invention, the percentage utilization of a CPU is a measure of how "busy" a processor is at any given time. The determination of speed in the present invention is not necessary rather just how much of the processor is being consumed. This is important because often times in the downloading step it is the utilization (especially the processor I/O) which determines how fast something is downloaded. The CPU speed difference is negligible. Furthermore, the CPU utilization changes over time, the processor speed is

fixed.² To use an analogy of a measuring cup used in cooking, and the "processor speed" or "CPU speed" is a measure directed to a size of a measuring cup whereas, the "percentage CPU utilization" refers to how full is the measuring cup. The two are different. Accordingly, independent claims 1, 9, 11, 19, and 21 distinguish over Miller taken alone and/or in view of Klug for at least this reason.

Moreover, the Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness cannot be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here the intent, purpose and function of Klug taken alone or in view of Miller is the measure of "processor speed", in contrast to the intent and purpose of the present Invention which is the measure of "percentage of CPU utilization". The present invention is more accurate in measuring the amount of CPU available at any given time, whereas CPU speed is constant over time. This combination, as suggested by the Examiner, destroys the intent and purpose of Klug taken alone or in view of Miller's teaching of measuring "processor speed". Accordingly, independent claims 1, 9, 11, 19, and 21 of the present invention distinguish over Miller taken alone and/or in view of Klug for this reason as well.

Continuing further, although Klug states in paragraph 0053:

"Ideally, as many of these factors as possible should be taken into account in determining the approximate waiting time. For example, the headers of protocol communications between the browser and the selected website convey information regarding the quantity of information that is to be downloaded."

Klug is completely silent on using a weighted sum of for two or more of these factors including CPU utilization and response time. Again, Klug is expressly teaching CPU speed not CPU utilization and the two are not the same. The use of a weighted sum

² To be complete in more advanced processor designs, the actual processor speed may be throttled for portable devices, such as for laptop computers, in an effort to conserve battery life but this is different than CPU percentage utilization which changes based on the demands of each process and/or application running.

ensures a common magnitude for each value in the summation is the same i.e. "where the weighted sum rescales at least one of the response time and the CPU utilization to provide a sum of at least two quantities with a given numeric order of magnitude."

Lastly, the Examiner states on page 3 that "*Therefore, one of ordinary skill in the art [...] would have found it obvious to implement or incorporate pinging, obtaining CPU utilization, calculating a result, and determining a download time in Miller's method in order to gain some information regarding the approximated waiting time before files are actually downloaded.*" The Applicants respectfully disagree. As noted above, Miller is directed to CPU speed, not utilization. Further there is no suggestion or teaching to use a weighted sum when calculating wait time. Of course if the Examiner takes official notice on facts outside the record and "when a rejection is based on facts within the personal knowledge" of the Examiner, the Applicants may require an affidavit from the Examiner to support such personal knowledge. The Applicants respectfully request such an affidavit from the Examiner to put these facts on the record.³ The Federal Circuit very recently again took up the identical question of Obviousness in combining references in the case *In re Sang Su Lee*, No. 00-1158 (January 18, 2002). In this case, the Board of Patent Appeals rejected all of Applicant's pending claims as obvious under § 103. The Federal Circuit vacated and remanded. Citing two prior art references, the Board stated that a person of ordinary skill in the art would have been motivated to combine the references based on "common knowledge" and "common sense," but it did not present any specific source or evidence in the art that would have otherwise suggested the combination. The Federal Circuit held that the Board's rejection of a need for any specific hint or suggestion in the art to combine the references was both legal error and arbitrary agency action subject to being set aside by the court under the Administrative Procedure Act (APA). Accordingly, with the suggestion or motivation found in Klug taken alone and/or in view Miller, the Examiner has failed to properly establish a *prima facie* case of obviousness of the invention as a "whole." The Applicants submit the present invention distinguishes over Klug taken alone and/or in view Miller for at least this reason as well.

³ See MPEP § 2144.03,

For the foregoing reasons, independent claims 1, 9, 11, 19, and 21 distinguish over Miller taken alone and/or in view of Klug. Claims 2-8, and 12-18 depend from independent claims 1, and 11 respectively. Since dependent claims contain all the limitations of the independent claims, claims 2-8, and 12-18 distinguish over Miller taken alone and/or in view of Klug, as well, and the Examiner's rejection should be withdrawn.

CONCLUSION

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith in the disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

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